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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,826	02/11/2002	Robert J. Medoff	U 013871-4	5504

140 7590 04/18/2005

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NEW YORK, NY 10023

EXAMINER

ROBERT, EDUARDO C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/073,826	Applicant(s) MEDOFF, ROBERT J.	
	Examiner Eduardo C. Robert	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19, 20 and 37-60 is/are pending in the application.
- 4a) Of the above claim(s) 2-17, 19, 20, 41, 43-47, 49, 51-55 and 57-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 37-40, 42, 48, 50 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/8/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Invention I (claims 1-17, 19-20, 37-51, 56 and new claims 57-60) and Species X, i.e. Figures 30 and 31, in the replies filed on September 17, 2004 and January 4, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without traverse** (MPEP § 818.03(a)).

It is acknowledged that applicant believes new claims 57-60 are linking claims between the Inventions I (apparatus) and Invention II (method). It is noted that new claims 57-60 are not "linking" claims because they do not link the Invention I (apparatus) with the Invention II (method). Claims 57-60 are only dependent claims which include all the limitations of the parent claim 37 and invention II (method) does not require all the limitations of the apparatus, as claimed in claim 37. One could practice the invention II, e.g. claim 52, with an implant that does not have a means associated with the second leg as required in claim 57. It is noted that a linking claim is a claim that can not be separated from the any of the inventions, and clearly the "supposed" linking claims which are part of the apparatus, because they depend from the apparatus, can be separated.

It is acknowledged that applicant believes claims 1-12, 14, 17, 37-40, 42, 43, 48, 50, and 56-60 read on the elected Species X, i.e. Figures 30 and 31. It is noted that comparison of the claims with Figures 30 and 31 and the specification shows, however, that the Species X, i.e. Figures 30 and 31, does not have a tensioning device as required by claims 2, 11, and 43. Also, the Species X does not have second portion integrally formed with the first portion by a bend

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(one bend) and the first portion further has two spaced wires as required by claims 3, 4, 6-9, 12, 14, and 17. Also, the Species X does not have the wires of the second portion crossing one another as required by claim 5. The Species X does not have a U-shaped bend portion and wires of the second portion being non-planar as required by claim 10. The Species X, i.e. Figures 30 and 31, does not have or is disclosed to require the application of a pulling force as required by claims 57-60.

Claims 2-17, 19, 20, 41, 43-47, 49, 51-55, and 57-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention and Species, there being no allowable generic or linking claim. The election was treated as an election **without** traverse.

The requirement is made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 56 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 56, line 2, "the wires of said first and second portions" lacks a prior antecedent.

Claim Rejections - 35 USC § 102

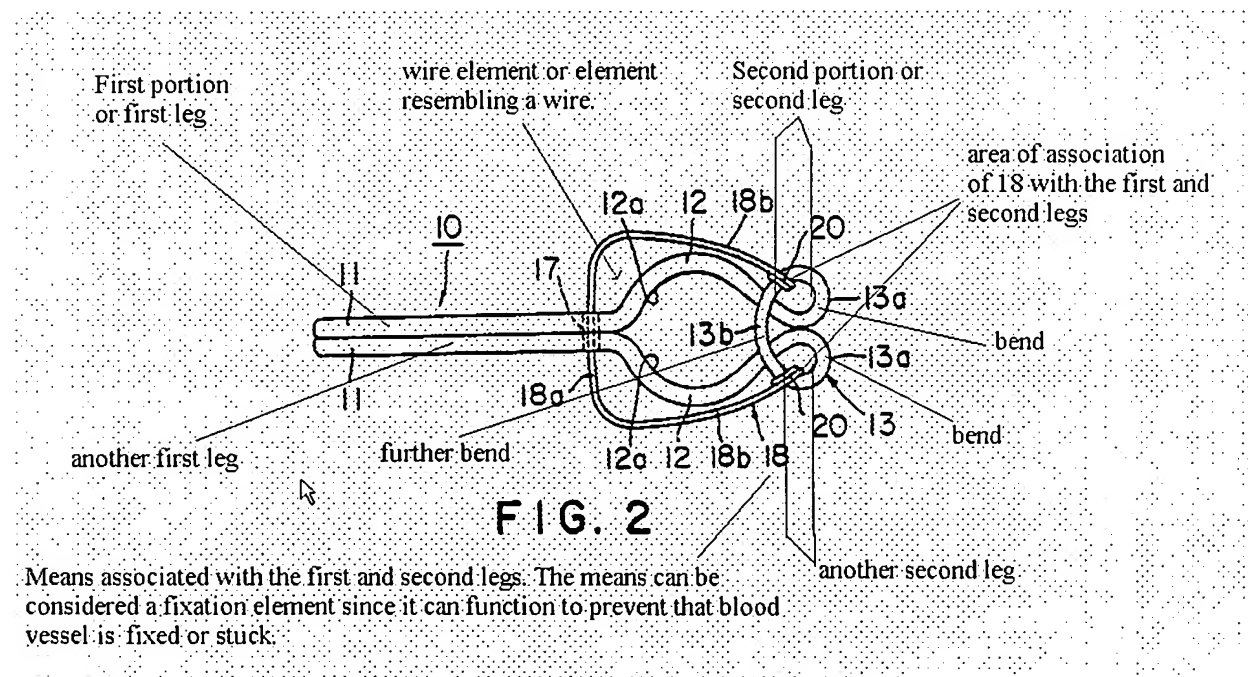
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 37-39, 42, 48, 50, and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Segawa et al. (U.S. Patent No. 5,312,426).

Segawa et al. disclose an apparatus comprising a first portion or first leg, a second portion or second leg integrally formed with the first portion or leg by a bend, and a means 18 associated with the second leg (see Figure 2 below). It noted that the means 18 can be considered as a fixation element since it can function to prevent that a blood vessel is fixed or stuck.



The apparatus can be considered a wire element since it resembles a wire that has been twisted. Actually, as shown above, the wire element has two first portions or legs and two second portions or legs, each being joined by respective bends and the two second portions or legs are connected together by a further bend which lies in a plane with the second legs. The first and second legs have different cross-sectional areas and diameters (see Figure 3). The second legs are spaced from one another (see Figure 2 above). The first legs extend beyond the second legs (see Figure 2 above). With regard to the functional language recited in the claims, e.g. "adapted to ...", etc., it is noted that the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. In the instant case the apparatus of Segawa et al. has the ability to perform the function recited in the claims if one so desire.

Claim Rejections - 35 USC § 103

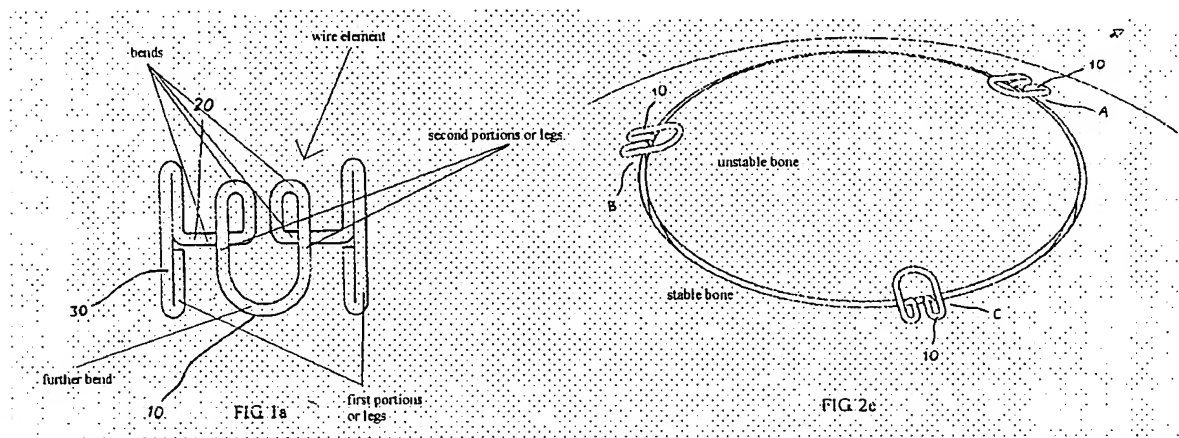
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 37-39, 40, 42, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Patent No. 6,554,835) in view of Medoff (U.S. Patent No. 5,709,682).

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Lee discloses an apparatus comprising a wire element or element resembling a wire, the element includes first portions or legs, second portions or legs, bends connecting the first portions with the second portions, and a further bend connecting the second portions or legs (see Figure 1a below). The apparatus is used to attached an unstable bone to stable bone (see Figure 2e below). The first and second portions of the apparatus of Lee have the ability to perform the function recited in the claims if one so desire.



Lee discloses the claimed invention except for the apparatus having a washer and bone screw. Medoff discloses an apparatus having first portions or legs and second portions or legs, and a washer, e.g. 96, engageable with the second portion legs and a bone screw, e.g. 94. The washer and bone screw secured the apparatus to a stable bone. It would have been obvious to one skill in the art at the time the invention was made to construct the apparatus of Lee including a washer and bone screw in view of Medoff, in order to secure more the apparatus to a stable bone, thus insuring that the unstable bone portion does not move.

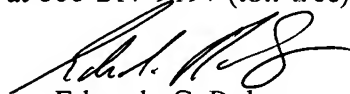
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 571-272-4719. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 571-273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.